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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Bayer Corporation
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EXAMINER

YOON, TAE H

ART UNIT PAPER NUMBER

1714

DATE MAILED: 12/04/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/06/8.126

Applicant(s)

Reitze et al

Examiner

T. Yoon

Group Art Unit

1714

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 11-6-02

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-5, 7-10 and 12-29

is/are pending in the application.

Of the above claim(s)

is/are withdrawn from consideration.

☐ Claim(s)

is/are allowed.

☒ Claim(s) 1-5, 7-10 and 12-29

is/are rejected.

☐ Claim(s)

is/are objected to.

☐ Claim(s)

are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5, 7-10 and 12-29 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the mould release agent from the polyol component (I) having 4 or more and even numbered hydroxyl groups, does not reasonably provide enablement for the mould release agent from the polyol component (I) having 3 or more and odd numbered hydroxyl groups. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The claim 1 now recites "the number of esterified groups and free hydroxyl groups of said polyol component (I) being the same". Thus, for example, the polyol component (I) having 3 hydroxyl groups cannot meet the recited limitation since one esterified group leaves two free hydroxyl groups or two esterified groups leaves one free hydroxyl group. Said limitation cannot be applied to the polyol component (I) having the odd numbered hydroxyl groups. In another words, the polyol component (I) having 3 (and odd numbers higher than 3) hydroxyl groups has no place in the claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-5, 7-10 and 12-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The originally recited “---a parent substance with 4 or more carbon atoms, 3 or more hydroxyl groups, more than one hydroxyl group esterified with aliphatic carboxylic acids” and newly recited “the number of esterified groups and free hydroxyl groups of said polyol component (I) being the same” constitutes a range within a range which is indefinite since there can be only the polyol component (I) having 4 or more and even numbered hydroxyl groups which meet the newly recited limitation.

The recited “---polyol components with less than one free hydroxyl group with less than two esterified hydroxyl groups” in claims 8 and 25-27 lacks an antecedent basis in claim 1 since new limitation recites at least two free hydroxyl groups (one free hydroxyl group cannot be exist as the reason given above regarding the even and odd numbers of hydroxyl groups). Also, the polyol component with less than two (which is one in another words) esterified hydroxyl groups cannot be exist since the minimum number of hydroxyl groups must be four (and thus yielding two esterified hydroxyl groups) in order to meet the newly recited limitation.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-10 and 12-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adelman et al (US 4,131,575).

Rejection is maintained for reason of record and following.

Adelman et al teach partial esters utilizing pentaerythritol (four OH groups) and stearic acid (one COOH groups) [and dodecane diacid (two COOH groups)] at col. 11, lines 6-28.

The instant invention recites the equal number of esters and hydroxyl groups.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to make and use a pentaerythritol distearate which is a partial ester. Applicant's comparison example-3 using tetraester of pentaerythritol (no hydroxyl group) failed to overcome the partial ester pentaerythritol taught by Adelman et al since said the partial ester encompasses at least one free hydroxyl group for said pentaerythritol. Applicant failed to show any unexpected result.

Claims 1-5, 7-10 and 12-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adelman et al (US 4,131,575) in view of Dunay et al (US RE 37,200) or EP 0 511 640.

Rejection is maintained for reason of record and following.

Dunay et al and EP are recited to show a polycarbonate having trimethylcyclohexyl bisphenol component and compact discs and DVDs over Adelman et al who already teach the

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partial ester pentaerythritol as discussed above. Thus, argument based on the absence of the mold release agent in Dunay et al and EP has no probative value.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

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Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/December 3, 2002



TAE H YOON
PRIMARIAL EXAMINER